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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/425,739	10/22/1999	CHARLES A. PEYSER	020748.0104PTUS	9954
44124 7590 04/02/2008 PATTON BOGGS, LLP 2001 ROSS AVENUE, SUITE 3000 DALLAS, TX 75201				
EXAMINER				
FADOK, MARK A				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/425,739

Applicant(s)

PEYSER ET AL.

Examiner

MARK FADOK

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/5/2007 has been entered.

Claim Rejections - 35 USC §101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 8 is rejected because these claims recite functional descriptive material which is not tangibly embodied on a medium and is therefore deemed to be non-statutory subject matter as per MPEP 2106.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Priority

The later-filed application must be an application for a patent for an invention, which is also disclosed, in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/138,509, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. In this case the provisional application does not provided support for bidding in "spot markets" as described in the claims and specification pages 18 and 19 with particular attention to the feature preventing the requester from accepting the identical response after the session is terminated.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoham et al (6,584,451) in view of Johnson (US 6,047,274) in view of Official Notice and further in view of Hanson (US 5974398) and further in view of Fusz (US 7,133,835) and further in view of Telezoo (an article found in PTO 892).

In regards to claims 1,2,4-9, Shoham teaches all the features of the instant claims except as noted below. For instance, Shoham discloses saving pricing schedules to a database for a third party to provide responses to RFQs (col 5, lines 15-65, Fig 1), receiving a request after the schedules have been saved in the database (FIG 4), preventing a requester from accepting the identified response after the session is terminated by the requester (col 6, lines 1-8, since the buyer needs to be committed (in session) in order to maintain the current schedule, withdrawing or terminating the session would result in the buyer being subject to a new schedule if they decide to enter a new session) and preventing a service provider from modifying the set of responses during the session (col 6, lines 1-8).

Applicant may argue that being committed is not the same as terminating a session. In this case Johnson is reintroduced to teach "preventing a requester from accepting the identified response after the session is terminated by the requester".

Johnson teaches specifying a start and termination time where the bid is void once the session has ended (Johnson, col 12, lines 37-55). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Shoham preventing a requester from accepting the identified response after the session is terminated by the requester, because the bid may be for energy that is in excess at the time and offering the same bid amount at a later time may be too low due to the energy being in short supply, thus causing the seller to lose money on the deal.

Shoham discloses a method and system according to claim 1, 8 and 9 as indicated supra, but does not specifically mention that the sales area is limited by the seller. Hanson teaches matching buyers to sellers in a specified geographical region (Hanson, FIG 2 and 3, col 6, lines 20-40). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Shoham limiting the area that a seller wishes to target, because this will reduce costs and increase revenue by only selling to buyers who are local and can be serviced in an inexpensive manner (see Fusz col 2, lines 15-20).

In regards to claims 1, 2, 4-9, Shoham discloses a method and system according to claim 1, 8 and 9 as indicated supra. Shoham does not expressly disclose the purchasing of telecommunication services. Shoham does disclose online sales useful for a plurality of generic goods and services (Shoham: abstract). The differences, not including telecommunication services explicitly is only found in the non-functional data stored. Data identifying a product useful to a particular business is not functionally related to the substrate of the invention. Thus, this descriptive material will not

distinguish the claimed invention from the prior art in terms of patentability, see Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any data in the fields of the invention as shown in *Shoham*, because such data does not functionally relate to the substrate of the invention and merely labeling the data differently from that in the prior art would have been obvious matter of design choice. See *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

Although the examiner does not acquiesce that the use of Telecommunications as a non-limiting factor, the examiner provides Telezoo as an example of a company that sells telecommunication products through a RFP process that allows users to compare prices (see entire article). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include selling telecommunications, because this would increase the revenue to a site by including what might amount to a billion dollars in sales through the portal.

Further, it is noted that all of the elements of the cited references perform the same function when combined as they do in the prior art . Thus such a combination would have yielded predictable results (see *Sakraida*, 425 US at 282, 189 USPQ at 453. Since the independent claims only unite old elements with no change in there respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Response to Arguments

Applicant's arguments with respect to claims 1,2,4-9 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that Hanson only refers to advertisements. The examiner disagrees and directs the applicant's attention to para 6, lines 20-40 and the discussion of a "bid" being made in the form of a "offer" based at least upon the indication that buyer is in a specified geographic location. The use of the geographic location provides targeted offers to buyers that are in a specific location.

Applicant argues that Shoham teaches away from limiting the pooling of customers based on geographic region. As stated in MPEP 2123[R-5]I "Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) Furthermore, "[t]he prior art's mere disclosure of more than one alternative does not

constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....” In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004)”.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300 [Official communications; including

After Final communications labeled

"Box AF"]

For general questions the receptionist can be reached at

571.272.3600

Information regarding the status of an application may be obtained from the

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Fadok/

Primary Examiner, Art Unit 3625